

REMARKS

In response to the Restriction Requirement, Applicants have elected the sequences of SEQ ID NO:39, SEQ ID NO:43, SEQ ID NO:44, and SEQ ID NO:45 for examination with traverse. The reasons for traverse are set forth below.

Applicants first wish to thank the Examiner for her willingness to examine up to four sequences, notwithstanding the original restriction to a single claimed sequence.

Applicants believe the eight nucleotide sequences listed in claim 10 should not be subject to a restriction requirement under 35 U.S.C. 121, 37 C.F.R. § 1.141, and M.P.E.P. 2434 as applied by the Examiner because the oligonucleotides are not properly the subject of M.P.E.P. 2434. Applicants further respectfully point out that the Examiner has incorrectly characterized the oligonucleotide sequences of claim 10 as antisense sequences.

Applicants disagree with the basis for the restriction of the claims to a single oligonucleotide sequence. The Examiner's reliance on M.P.E.P. 2434 is misplaced. The oligonucleotides described in the claims are different from the nucleic acids covered under the requirements limiting examination to 1-10 sequences set forth in M.P.E.P. 2434. The claimed class of oligonucleotides share a common structural motif, similar to a chemical structure, and have common functional properties. The class of oligonucleotides should be treated as a species of the generic formula presented in claim 1 rather than as completely separate and distinct nucleic acid sequences. The nucleic acids that are subject to restriction under M.P.E.P. 2434 are unrelated nucleic acids. The oligonucleotides that are the subject matter of the instant claim made subject to the Restriction Requirement are a related class of chemical compounds having a generic common structural entity.

The rules relating to restriction practice set forth in 1192 O.G. §68, as embodied in M.P.E.P. 2434, were implemented for the purpose of managing large numbers of unrelated nucleic acids generated using automated sequencing equipment and incorporated into a single patent application.¹ The eight nucleic acid sequences in this instance can hardly be characterized as a large number of sequences. The class of compounds claimed in the above-identified patent application are not unrelated nucleic acids and they were not generated using automated sequencing equipment.

¹ "Scientific and technological advances now permit researchers to identify large numbers of gene sequences rapidly. The ease of using automated techniques for sequencing large numbers of nucleotides in a nucleic acid has resulted in the filing of a growing number of patent applications, many of which recite thousands of individual nucleotide sequences with each sequence reciting at least several hundred nucleotides. The examination of these

According to 1192 O.G. §68 the basis for restricting examination of a patent application to a single nucleotide sequence is found in 35 U.S.C. § 121 and 37 CFR 1.142(a) which indicate that each patent application should be limited to a single distinct invention. A single distinct invention is defined in 1192 O.G. §68 in the following terms: "Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. § 121."²

The class of compounds of the instant invention are not nucleic acid sequences encoding different proteins. The compounds claimed in the instant invention are chemical compounds having common structural and functional properties that happen to be nucleic acids. These nucleic acids do not encode for proteins.

Accordingly, Applicants request that the Restriction Requirement with respect to the eight oligonucleotide sequences of claim 10 be withdrawn.

Applicants expressly reserve the right to file one or more divisional applications on the subject matter of the nonelected sequences. If the Examiner has any questions or comments, she is encouraged to contact the Applicants' representative at the number listed below.

Prompt and favorable action on Response is respectfully requested.

Respectfully submitted,



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applications presents unprecedented search and examination challenges, even with the most modern, up-to-date equipment." 1192 O.G. §68 (November 19, 1996).

² "Examples of typical nucleotide sequence claims impacted by this Notice include: (1) an isolated and purified DNA fragment comprising DNA having at least 95% identity to a DNA sequence selected from SEQ ID Nos. 1-1,000; (2) a combination of DNA fragments comprising SEQ ID Nos. 1-1,000; and (3) a combination of DNA fragments, said combination containing at least thirty different DNA fragments selected from SEQ ID Nos. 1-1,000." 1192 O.G. §68 (November 19, 1996). None of these examples are appropriate to the claimed compounds described in the instant invention.